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8 Attorneys for Plaintiff  
9 WINE SCOUT INTERNATIONAL

10 UNITED STATES DISTRICT COURT  
11 NORTHERN DISTRICT OF CALIFORNIA

12 Wine Scout International,  
13 Plaintiff,  
14 vs.  
15 Patricia Crowell,  
16 Defendant.

CASE NO. C 07 05930 JSW

**PLAINTIFF'S OPPOSITION TO  
DEFENDANT'S MOTION TO ENLARGE  
TIME FOR THE FILING OF  
RESPONSIVE PLEADINGS**

17 Plaintiff, Wine Scout International, hereby opposes defendant, Patricia Crowell's Motion  
18 to Enlarge Time for the Filing of Responsive Pleadings. For the reasons stated below, Plaintiff  
19 requests that the motion be denied in its entirety without hearing.

20 **FACTS**

21 A detailed timeline setting forth the extensive interaction between the parties related to the  
22 infringement at issue in this matter, the receipt of the Complaint by Defendant three months ago,  
23 Plaintiff's numerous accommodations to Defendant concerning her response to the Complaint,  
24 and Defendant's retention of local counsel a mere one day prior to the stipulated extension  
25 deadline to answer or otherwise plead, is included in the Declaration of J. Scott Gerien in Support  
26 of Plaintiff's Opposition to Defendant's Motion to Enlarge Time for the Filing of Responsive

Pleadings (“Gerien Decl.”), submitted herewith.

### ARGUMENT

Defendant has not carried her burden of establishing the “substantial harm or prejudice that would occur if the Court did not change the time” to respond to the complaint as required by Civil L.R. 6-3(3). Instead, Defendant asserts that there is plenty of time until the case management conference, Plaintiff will not be prejudiced by the extension and that Plaintiff is simply taking part in what Senator Barak Obama has termed a “silly season” of posturing.

Defendant’s motion is insulting to both Plaintiff and this Court as Defendant is requiring the Plaintiff and this Court to unnecessarily expend time and resources on this motion simply because Defendant “wants” more time, even though she has been in possession of the Complaint for three months.<sup>1</sup> This is unacceptable. Plaintiff will in fact be prejudiced if this motion is granted because Defendant will be allowed additional time to answer and potentially formulate unwarranted counterclaims as threatened by Defendant’s counsel, despite the fact that Defendant did not act promptly in retaining local counsel in this matter. *See* Gerien Decl., ¶¶11-12.

1. There is no Substantial Harm or Prejudice to Defendant if the Motion for Enlargement of Time is Denied

In her moving papers, Defendant acknowledges that there is no substantial harm or prejudice to her if this motion for enlargement of time to respond to the complaint is denied. Instead, Defendant attempts to turn this factor around on Plaintiff by asserting that Plaintiff will not be harmed if the extension is granted. *This is not the standard.* As the party requesting the relief, Defendant carries the burden of proving her substantial harm or prejudice so as to merit such relief. Furthermore, Plaintiff *will* be prejudiced if the requested extension is granted.

Plaintiff has diligently prosecuted this action providing the Defendant with a courtesy

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<sup>1</sup> Aware that she has had the complaint for three months, Defendant incredibly argues that New York counsel was not acting as counsel to Defendant in this litigation. Clearly, the facts as demonstrated in the accompanying declaration demonstrate otherwise. *See* Gerien Decl. ¶¶2-10, Exhibits 1, 3, 5.

1 copy of the complaint immediately after it was filed three months ago, allowing Defendant 60  
 2 days to answer through the Waiver of Service provisions of FRCP 4, extending that deadline  
 3 another two weeks at the request of Defendant, and agreeing to grant a further two week  
 4 extension when Defendant “began” to retain local counsel one day prior to the first extended  
 5 deadline to answer. *See* Gerien Decl., ¶¶3, 5, 8, 11.

7 Plaintiff has been extremely generous in allowing Defendant three months to respond to  
 8 the Complaint. Now Defendant’s new local counsel has threatened Plaintiff with a counter claim  
 9 and wants additional time to draft this counterclaim despite Defendant’s possession of the  
 10 complaint for three months. *See* Gerien Decl., ¶¶3, 11-12. Thus, granting additional time to  
 11 Defendant will clearly prejudice Plaintiff by providing a tactical advantage to Defendant and  
 12 cutting in to Plaintiff’s time to respond to such counterclaims ahead of the case management  
 13 conference, as well as Plaintiff’s time to prepare discovery to efficiently use the discovery period  
 14 once it opens. On this basis, the motion for enlargement of time should be denied.

16  
 17 2. The Fact that Defendant Allegedly did not Receive the Case Management Conference  
Order is of No Import

18 Defendant has failed to demonstrate how the allegation that she did not receive the Order  
 19 Setting Case Management Conference before Judge White is even relevant to the need for an  
 20 order extending time to answer when Defendant has been in possession of the Complaint for three  
 21 months. *See* Gerien Decl., ¶3. Reassignment of the case or the issuance of a new Order Setting  
 22 the Case Management Conference does not affect the deadline for filing an Answer.

24 Furthermore, had Defendant or counsel for Defendant registered with ECF, Defendant  
 25 would have promptly received a copy of such Order. *See* Gerien Decl., ¶9, Exhibit 4. Even if  
 26 Defendant did not *receive* such Order as she alleges, her counsel clearly obtained such Order and  
 knew that the matter had been reassigned to Judge White as demonstrated by counsel’s email of

1 January 28, 2008. *See* Gerien Decl., ¶10, Exhibit 5. Thus, this claim by Defendant appears to be  
 2 entirely contrived.

3 3. The Pending Action at the PTO is not Relevant

4 Defendant also asserts that she has submitted an amendment to her pending trademark  
 5 application which she believes will “moot” certain issues raised in the Complaint. While Plaintiff  
 6 disagrees with the proposition that Defendant’s answer will be changed in any manner if the  
 7 amendment to the trademark application is granted, this proposition itself is moot as the PTO will  
 8 very certainly not make any further decisions on the pending application in light of this litigation.  
 9

10 On January 14, 2008, Plaintiff filed a Letter of Protest to suspend Defendant’s trademark  
 11 application pending the outcome of this litigation. *See* Gerien Decl., ¶7, Exhibit 2. Since the  
 12 PTO has not yet acted on this Letter of Protest and the application has been published, to remove  
 13 any doubt as to the primacy of this federal court action, Plaintiff has filed a Notice of Opposition  
 14 against Defendant’s application and a Motion to Suspend the Opposition. *See* Gerien Decl.,  
 15 ¶¶14-15, Exhibits 7-8. Pursuant to the Trademark Trial and Appeal Board Manual of Procedure  
 16 (“TBMP”), “the decision of the Federal district court is often binding on the Board,” and  
 17 “[o]rdinarily, the Board will suspend proceedings in the case before it if the final determination of  
 18 the other proceeding will have a bearing on the issues before the Board.” TBMP §510.02(a).  
 19

20 Thus, even though Defendant’s claim that the proceedings in the Trademark Office would  
 21 somehow impact her Answer in this action is without merit, the Trademark Trial and Appeal  
 22 Board will certainly suspend any action on Defendant’s trademark application in deference to the  
 23 decision of this Court. Thus, this should not serve as a basis for an enlargement of time to  
 24 answer.  
 25

26 4. Plaintiff’s Refusal to Stipulate to Further Extensions of Time to Answer Requested by Defendant’s Counsel is Entirely Justified

Defendant’s local counsel asserts Plaintiff’s counsel “shut tight” the door for

1 consideration of enlargement of time absent consideration of the fact that Defendant's local  
 2 counsel was new to the case. This is false. Despite the fact that Defendant's local counsel  
 3 contacted Plaintiff's counsel the day before the stipulated deadline to answer to request additional  
 4 time, Plaintiff's counsel indicated it was willing to give a two week extension to answer, but  
 5 believed anything beyond that was unreasonable in light of Defendant's possession of the  
 6 complaint for 10 weeks. *See* Gerien Decl., ¶¶ 11-12, Exhibit 6. Plaintiff stands by its position and  
 7 it is in fact Defendant's counsel that is being unreasonable in preparing and filing this motion and  
 8 attendant declarations when such time could have been spent on preparing an answer to be filed  
 9 by the February 29, 2008 deadline extension granted by Plaintiff.  
 10

### 11 CONCLUSION

12 This motion should be denied in its entirety as it reflects nothing more than Defendant's  
 13 request that she be excused from complying with the response deadlines of the Federal Rules and  
 14 Local Rules because she was dilatory in retaining local counsel and responding to the Complaint  
 15 in this matter. Plaintiff has been generous in providing extensions to Defendant and is deserving  
 16 of a prompt response to the Complaint after three months of waiting so that Plaintiff may prepare  
 17 discovery in this case.  
 18

19 Dated: 2/26/08

20 Respectfully submitted,

21 DICKENSON, PEATMAN & FOGARTY

22 By 

23 J. Scott Gerien  
 24 Megan Ferrigan Healy  
 25 809 Coombs Street  
 26 Napa, California 94559  
 Telephone: 707-252-7122  
 Facsimile: 707-255-6876

Attorneys for Plaintiff,  
 Wine Scout International

**PROOF OF SERVICE**

I declare that I am over the age of 18 years, employed in the County of Napa, and not a party to the within action; my business address is 809 Coombs Street, Napa, California 94559.

On February 26, 2008, I placed a copy of the following document(s):

- **PLAINTIFF'S OPPOSITION TO DEFENDANT'S MOTION TO ENLARGE TIME FOR THE FILING OF RESPONSIVE PLEADINGS**
- **DECLARATION OF J. SCOTT GERIEN IN SUPPORT OF PLAINTIFF'S OPPOSITION TO DEFENDANT'S MOTION TO ENLARGE TIME FOR THE FILING OF RESPONSIVE PLEADINGS**

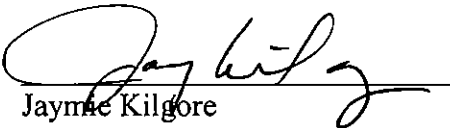
in a sealed envelope addressed as shown below and placing the envelope for collection and mailing following our ordinary business practices. I am readily familiar with this business' practice for collecting and processing correspondence for mailing. On the same day that correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service in a sealed envelope with postage fully prepaid.

The persons served are as follows:

Stephen N. Hollman, Esq.  
Business & Technology Law Group  
160 W. Santa Clara Street, Suite 1050  
San Jose, CA 95113

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed February 26, 2008, at Napa, California.

  
Jaymie Kilgore  
Legal Secretary

J. SCOTT GERIEN, State Bar No. 184728  
MEGAN FERRIGAN HEALY, State Bar No. 229177  
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Attorneys for Plaintiff  
WINE SCOUT INTERNATIONAL

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

Wine Scout International,  
  
Plaintiff,  
  
vs.  
  
Patricia Crowell,  
  
Defendant.

CASE NO. C 07 05930 JSW

**DECLARATION OF J. SCOTT GERIEN  
IN SUPPORT OF PLAINTIFF'S  
OPPOSITION TO DEFENDANT'S  
MOTION TO ENLARGE TIME FOR THE  
FILING OF RESPONSIVE PLEADINGS**

I, J. Scott Gerien, declare as follows:

1. I am an attorney in good standing licensed to practice by the State Bar of California. I am employed by the law firm of Dickenson, Peatman & Fogarty, located at 809 Coombs Street, Napa, California. I am counsel for Plaintiff, Wine Scout International ("Wine Scout" or "Plaintiff"). I submit this declaration in support of Plaintiff's Opposition to Defendant's Motion to Enlarge Time for the Filing of Responsive Pleadings. I have personal knowledge of the facts stated herein and if called to testify upon same could and would do so willingly.

2. On October 8, 2007, I sent a demand letter to Andres Madrid for claims of trademark infringement against Patricia Crowell related to her use and application to register the mark WINE SCOUT. Mr. Madrid is counsel of record for Ms. Crowell on her pending

1 U.S. trademark application. Following this initial demand letter was an exchange of  
2 correspondence on the matter, culminating in a letter from Mr. Madrid on November 13,  
3 2007, wherein he indicated that Ms. Crowell would not cease her use of THE WINE SCOUT  
4 mark and further demanding that my client cease use of its WINE SCOUT mark and stating  
5 that if Wine Scout did not, Ms. Crowell would "take all necessary steps to protect her  
6 valuable intellectual property rights."

7  
8 3. On November 26, 2007, Plaintiff filed the complaint in this matter. On  
9 November 27, 2007 I sent an email to Mr. Madrid with a courtesy copy of the complaint  
10 advising him that if his client agreed to cease use of the mark we could resolve the matter  
11 absent litigation. I gave him a deadline of November 30, 2007 to respond, notifying him that  
12 otherwise Plaintiff would proceed with litigation and seek all available damages.

13 4. On November 28, 2007, Mr. Madrid requested an extension of time until  
14 December 7, 2007 to respond to the settlement offer. I advised Mr. Madrid that I would  
15 agree to the extension until December 7, 2007 if he would accept service of the complaint on  
16 behalf of his client. Rather than accept this offer, on November 29, 2007, Mr. Madrid  
17 instead requested evidence of our client's trademark rights, evidence which had already been  
18 provided in the exchange of demand letters. Mr. Madrid advised that if we provided him  
19 with this evidence, he would respond to such evidence within two weeks and agree to accept  
20 service if a resolution could not be reached.  
21

22 5. On December 3, 2007 we mailed Ms. Crowell a Notice of Lawsuit and  
23 Request for Waiver of Service of Summons to the address indicated on her U.S. trademark  
24 application. Pursuant to Rule 4 of the Federal Rules of Civil Procedure, Ms. Crowell was  
25 allowed until January 2, 2008 to return a signed waiver in order to avoid the costs of service.  
26 Not having received any waiver, on January 3, 2008, I contacted Mr. Madrid to inquire as to  
27 whether his client intended to sign the waiver, and gave him until January 7, 2008 to let me



1 know before we proceeded with personally serving the summons and complaint. On January  
2 4, 2008 Mr. Madrid contacted me and advised me that he had not heard from his "client,"  
3 anticipated hearing from her by January 7, 2008, and requested that I not serve the summons  
4 and complaint until I heard from him, to which I agreed. A true and correct copy of this  
5 email exchange is attached hereto as Exhibit 1, including Mr. Madrid's representation that  
6 Ms. Crowell was his client in the context of this litigation.

7  
8 6. On January 7, 2008, Mr. Madrid advised me that he would forward me Ms.  
9 Crowell's waiver on January 8, 2008. Despite the waiver being late, we accepted the waiver  
10 and permitted Ms. Crowell until February 1, 2008 to answer or otherwise respond to the  
11 complaint as permitted by Rule 4.

12 7. On January 14, 2008, Plaintiff filed a "Letter of Protest Pursuant to TMEP  
13 §1715" with the U.S. Patent and Trademark Office requesting that Ms. Crowell's pending  
14 trademark application be suspended pending the outcome of the subject litigation. The PTO  
15 has yet to consider the Letter of Protest. A true and correct copy of the Letter of Protest is  
16 attached as Exhibit 2.

17  
18 8. On January 22, 2008, Mr. Madrid contacted me and requested a further 30 day  
19 extension of time to answer on behalf of his client Ms. Crowell. In light of the upcoming  
20 meet and confer deadline scheduled for February 26, 2008, I felt a 30 day extension would  
21 put the answer too close to this deadline and instead, on that same day, agreed to a two week  
22 extension of time to answer. Mr. Madrid accepted such extension and thanked me for  
23 agreeing to such extension. Mr. Madrid further inquired as to whether I had a form for such  
24 an extension and I informed him I did not but that he should consult with the Local Rules for  
25 the Northern District. A true and correct copy of this email exchange is attached hereto as  
26 Exhibit 3.  
27

1           9.       On January 25, 2008, this matter was reassigned to Judge White. Based on  
2 my reading of the FAQs section for electronic filing for the Northern District, I did not  
3 believe that I needed to serve Judge White's Case Management Order as the case was already  
4 proceeding under ECF. According to FAQ SV02, "court's orders in efiled cases will be  
5 served via the email notice of electronic filing only, and no paper service will be made,  
6 regardless of whether counsel has yet registered as an efiler. It is hoped that this will provide  
7 a strong incentive to register for those who have not yet done so." I interpreted this to mean  
8 that I did not need to serve Judge White's order issued on January 25, 2008. A true and  
9 correct copy of this FAQs section is attached hereto as Exhibit 4. However, I generally  
10 recollect advising Mr. Madrid of the reassignment to Judge White, although I have no  
11 documentary correspondence to establish this.

12  
13           10.       On January 28, 2008 I received an email from Mr. Madrid with a proposed  
14 stipulation to extend time to answer on behalf of his client. In the email, Mr. Madrid states "I  
15 believe it complies with Judge White's standing order, but please let me have your  
16 comments." A true and correct copy of this email is attached as Exhibit 5. Thus, Mr. Madrid  
17 was clearly on notice that the matter had been reassigned to Judge White and clearly had  
18 access to the January 25, 2008 order. The stipulated extension was filed by Ms. Crowell  
19 extending the answer deadline to February 15, 2008.


20  
21           11.       On February 14, 2008, one day prior to Ms. Crowell's extended deadline to  
22 answer, I received a call from Stephen Hollman. Mr. Hollman advised me that he "believed"  
23 he would be representing Ms. Crowell in this matter but that formalities such as an  
24 engagement letter still needed to be worked out. He proposed a conference call for February  
25 19, 2008, to discuss various matters in the case, to which I agreed. He confirmed this with an  
26 email, to which I advised him that Plaintiff was not stipulating to any extensions at that time  
27 and would not consider any further extensions beyond February 29, 2008 at the latest, as Ms.

1 Crowell had had more than adequate time to respond to the complaint. A true and correct  
2 copy of this email exchange is attached hereto as Exhibit 6.

3 12. On February 19, 2008, Mr. Hollman contacted me and asked that the call be  
4 moved to February 20, 2008, to which I agreed. When we spoke on February 20, 2008, Mr.  
5 Hollman offered me two options: 1) a further extension of the deadline to respond, or 2) a  
6 suspension of proceedings so that the parties could pursue expedited ADR. I advised Mr.  
7 Hollman that the parties' positions seemed fairly established, so I was not interested in  
8 pursuing ADR at this time. I did not indicate that Plaintiff would not take part in any ADR  
9 and Plaintiff will comply with the District's requirement to take part in some type of ADR. I  
10 further advised Mr. Hollman that I would not stipulate to further extensions in the matter  
11 beyond February 29, 2008 as it was Plaintiff's position that Ms. Crowell has already had  
12 three months to consider the complaint and should be prepared to respond, and Plaintiff is  
13 entitled to have time to consider any response well ahead of the case management  
14 conference. During this call Mr. Hollman indicated he might have counterclaims which  
15 would require more time to draft. When I pressed him on what those counterclaims could be,  
16 he indicated he did not know.  
17

18  
19 13. Following my conference call with Mr. Hollman, I advised him that Plaintiff's  
20 prior settlement offer to waive damages and attorneys' fees in exchange for cessation of use  
21 of the mark was off the table and that Plaintiff would oppose any request for further  
22 extensions of time to respond.  
23

24 14. On February 25, 2008, Plaintiff filed a Notice of Opposition in the U.S. Patent  
25 and Trademark Office against Defendant's pending trademark application. A true and  
26 correct copy of this Notice of Opposition is attached hereto as Exhibit 7.  
27

  
J. SCOTT GERIEN

## **EXHIBIT 1**

**Scott Gerien**

---

**From:** Scott Gerien  
**Sent:** Friday, January 04, 2008 1:10 PM  
**To:** andy.madrid@madrid-law.com  
**Subject:** RE: Wine Scout v. Crowell

I will hold off until i hear from you

-----Original Message-----

**From:** "Andy Madrid" <andy.madrid@madrid-law.com>  
**To:** "'Scott Gerien'" <Sgerien@dpf-law.com>  
**Cc:** "'Megan Healy'" <MHealy@dpf-law.com>  
**Sent:** 1/4/08 12:54 PM  
**Subject:** RE: Wine Scout v. Crowell

Dear Scott: I am trying to reach my client. Right before the holidays, it was my understanding that she had received no communication from anyone regarding the case. I expect to hear from her Monday so I would ask that you hold off attempting formal service until you hear from me.

Regards.  
Andy Madrid

---

Andres N. Madrid, Esq.  
45 West 21st Street, Suite 5A  
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This e-mail may contain confidential communication. If you are not the intended recipient, you should: (1) Reply via e-mail to sender; (2) Destroy this communication entirely, including deletion of all associated text files from all individual and network storage devices; and (3) Refrain from copying or disseminating this communication by any means whatsoever. Thank you.

---

**From:** Scott Gerien [mailto:Sgerien@dpf-law.com]  
**Sent:** Thursday, January 03, 2008 5:41 PM  
**To:** madrid@madrid-law.com  
**Cc:** Megan Healy  
**Subject:** Wine Scout v. Crowell

Dear Andy:

Attached is a copy of the Request for Waiver of Service of Summons that was mailed to your client on December 3, 2007. We have not received back the signed Waiver from your client. Unless you advise us by Monday, January 7, 2008 that your client is willing to accept service, we will have a process server proceed with service and expect your client to reimburse our client for the costs of such service pursuant to the Federal Rules.

Sincerely,

Scott

J. Scott Gerien, Esq.

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## **EXHIBIT 2**



EV417415422US

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail in an envelope addressed to Office of the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on January 14, 2008.

Signed

Megan Ferrigan Healy

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark application of

Applicant: Patricia Crowell

Serial No.: 77/084749

Mark: THE WINE SCOUT

Classes: 9, 35, 41

Filed: January 17, 2007

Examining Attorney: Emily M. Chuo, Law Office 101

TO THE ADMINISTRATOR FOR TRADEMARK IDENTIFICATIONS, CLASSIFICATION  
AND PRACTICE

LETTER OF PROTEST PURSUANT TO TMEP §1715**I. Introduction.**

This Letter of Protest is filed by Wine Scout International, a California corporation ("Wine Scout"). Wine Scout is the owner of the service mark WINE SCOUT for various wine-related services, including mail order catalog services featuring wine, online retail store services featuring wine, and the provision of information and advice to catalog and online retail store customers concerning wine, and has used its WINE SCOUT mark on such services since as early as December 1996. Wine Scout is also the owner of the trade name Wine Scout International and uses such trade name as a négociant and vintner to have wines produced under various proprietary labels. Wine Scout has sold over one million bottles of wine featuring the Wine Scout International trade name as the producer and is known and referred to colloquially by the industry and the public by such trade name.

1 For the reasons discussed below, this Letter of Protest is filed by Wine Scout to  
2 respectfully request that prosecution of Application Serial No. 77/084749 for the mark THE  
3 WINE SCOUT be suspended.

4 **II. Federal Litigation is Pending Between the Parties.**

5 On November 26, 2007, Wine Scout filed a federal complaint against Applicant in the  
6 United States District Court for the Northern District of California alleging federal unfair  
7 competition, state unfair competition and the dissemination of false or misleading statements,  
8 and common law trademark infringement. Wine Scout's Complaint has been assigned Case No.  
9 C07-05930, and a copy is attached hereto as Exhibit 1. The Complaint requests as relief, among  
10 other things, that the Commissioner for Trademarks of the United States Patent and Trademark  
11 Office be directed to refuse and deny registration of the mark THE WINE SCOUT, as shown and  
12 specified in Application Serial No. 77/084749, based on a likelihood of confusion with Wine  
13 Scout's WINE SCOUT service mark and Wine Scout International trade name pursuant to 15  
14 U.S.C. 1052(d);

15 **III. Suspension of Prosecution of THE WINE SCOUT Application is Requested.**

16 Applicant's application for THE WINE SCOUT has been approved for publication and is  
17 scheduled to be published on February 12, 2008. TMEP § 1715.01(a)(3) instructs that it is  
18 appropriate for a third party to file a letter of protest requesting that prosecution of an application  
19 be suspended when there is pending litigation that is relevant to the registerability of the mark.  
20 The pending litigation between Wine Scout and Applicant is clearly relevant to the registerability  
21 of THE WINE SCOUT, as Wine Scout is requesting that the Commissioner for Trademarks of  
22 the United States Patent and Trademark Office be directed to refuse and deny registration of the  
23 mark. Accordingly, Wine Scout respectfully requests that Application Serial No. 77/084749 for  
24 the mark THE WINE SCOUT be suspended until the pending federal litigation between the  
25 parties is resolved.  
26

27 \* \* \*

1 If the Administrator or the Examining Attorney has any questions about this Letter of  
2 Protest, a call to the undersigned would be appreciated.

3  
4 Respectfully submitted,

5 DICKENSON, PEATMAN & FOGARTY

6  
7  
8 Date: 1/14/08

By 

J. Scott Gerien

Megan Ferrigan Healy

9  
10 Attorneys for Registrant  
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# **EXHIBIT 1**

J. SCOTT GERIEN, State Bar No. 184728  
MEGAN FERRIGAN HEALY, State Bar No. 229177  
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Attorneys for Plaintiff  
WINE SCOUT INTERNATIONAL

E-filing

ORIGINAL  
FILED

NOV 26 2007

RICHARD W. WIEKING  
CLERK, U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND

ADR

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

Wine Scout International,  
Plaintiff,  
vs.  
Patricia Crowell,  
Defendant.

CASE NO.

COMPLAINT

1. Federal Unfair Competition
2. California Unfair Competition
3. California False or Misleading Statements
4. Common Law Trademark Infringement

DEMAND FOR JURY TRIAL

Plaintiff, Wine Scout International ("Plaintiff"), for its complaint against Defendant, Patricia Crowell ("Defendant"), alleges as follows:

NATURE OF ACTION

1. This is an action to redress violations of the federal Lanham Act for unfair competition (15 U.S.C. §1125(a)), violations of the California Business and Professions Code for unfair competition (Cal. Bus. & Prof. Code §17200) and the dissemination of false and misleading statements (Cal. Bus. & Prof. Code §17500), and common law trademark infringement, as the result of willful and unauthorized use by Defendant of colorable imitations of Plaintiff's service mark and trade name, as more fully set forth hereinafter.

Plaintiff seeks preliminary and permanent injunctive relief restraining Defendant's

1 infringement of Plaintiff's service mark, monetary damages, attorneys' fees and related  
2 relief.

3 **THE PARTIES**

- 4 2. Plaintiff Wine Scout International is a California corporation with its principal place of  
5 business located at 975 First Street, Napa, California, 94559.  
6  
7 3. Upon information and belief, Defendant is an individual with a principal place of  
8 business located at PMB 110, 11357 Nuckols Road, Glen Allen, Virginia 23059.

9 **JURISDICTION AND VENUE**

- 10 4. This Court has subject matter jurisdiction over Plaintiff's claim under and pursuant to  
11 15 U.S.C. §1121 and 28 U.S.C. §1338(a), as the claims arise under the federal Lanham  
12 Act, 15 U.S.C. §§1051-1127. This Court also has pendent jurisdiction over all related  
13 claims herein in accordance with 28 U.S.C. §1338(b).  
14  
15 5. Upon information and belief, Defendant, either directly or through her agents,  
16 transacted business in the State of California and within this judicial district through the  
17 provision of services in this judicial district via a nationally accessible Internet website,  
18 as more specifically set forth below, and expected or should reasonably have expected  
19 her acts to have consequence in the State of California and within this judicial district.  
20  
21 6. Venue is proper in this district pursuant to 28 U.S.C. §1391(b), as Defendant is doing  
22 business in this judicial district through the provision of services via a nationally  
23 accessible Internet website, as more specifically set forth below, and therefore may be  
24 found in this district, and/or as a substantial part of the events giving rise to the claims  
25 alleged herein occurred in this judicial district, and/or the infringement occurred in this  
26 judicial district.  
27

DP&F

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**ALLEGATIONS COMMON TO ALL CLAIMS**

7. Plaintiff is the owner of the distinctive service mark WINE SCOUT for various wine-related services, including mail order catalog services featuring wine, online retail store services featuring wine, and the provision of information and advice to catalog and online retail store customers concerning wine (the "WINE SCOUT Service Mark").
8. Plaintiff is the owner of the trade name Wine Scout International as used in association with wine and various wine-related services (the "Wine Scout International Trade Name"). Plaintiff uses the Wine Scout International Trade Name as a négociant and vintner to have wines produced under various proprietary labels. Plaintiff has sold over one million bottles of wine featuring the Wine Scout International Trade Name as the producer. Plaintiff is known and referred to colloquially by the industry and the public by such Wine Scout International Trade Name.
9. Long prior to the acts of Defendant complained of herein, Plaintiff has used its WINE SCOUT Service Mark in association with its wine-related services in U.S. commerce, including mail order catalog services featuring wine, online retail store services featuring wine, the provision of information and advice to catalog and online retail store customers concerning wine.
10. Long prior to the acts of Defendant complained of herein, Plaintiff has used its Wine Scout International Trade Name in association with its wine-related services, including its négociant and vintner services, and in such capacity has produced over one million bottles of wine bearing the Wine Scout International Trade Name.
11. Plaintiff owns extremely valuable goodwill which is symbolized by its WINE SCOUT Service Mark and its Wine Scout International Trade Name and each use of the mark and the trade name substantially increases the value of Plaintiff's company and the salability of the goods and services sold through Plaintiff's company.

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1 12. Upon information and belief, Defendant, Patricia Crowell is the owner of an Internet  
 2 business operated under the service mark THE WINE SCOUT, accessible at  
 3 <http://thewinescout.com>, through which Defendant offers promotional services relating  
 4 to the advertisement and marketing of wine, wineries, wine tasting kits, wine vacations,  
 5 and other wine-oriented goods and services, provides audio and video podcasts and  
 6 other downloadable information about wine, and offers educational programs and travel  
 7 shows related to wine.

8  
 9 13. Defendant's website, accessible at <http://thewinescout.com>, prominently features the  
 10 mark THE WINE SCOUT throughout the site, as well as throughout Defendant's  
 11 downloadable wine-centered audio and video podcasts, programs, and blogs. Upon  
 12 information and belief, in addition to being available to consumers via Defendant's  
 13 <http://thewinescout.com> website, Defendant's downloadable THE WINE SCOUT  
 14 podcasts are available on Apple iTunes and numerous other podcast aggregators and  
 15 directories.

16  
 17 14. Upon information and belief, Defendant willfully adopted and initiated use of THE  
 18 WINE SCOUT service mark with prior knowledge of Plaintiff's WINE SCOUT  
 19 Service Mark and Wine Scout International Trade Name.

20 15. Upon information and belief, Defendant is the owner of pending federal Service Mark  
 21 Application Serial No. 77/084749 for the mark THE WINE SCOUT for "downloadable  
 22 podcasts relating to wines and restaurants distributed by means of a global computer  
 23 network" in International Class 9, "promotional services, namely advertising and  
 24 marketing for goods and services related to wine, online ordering and retail store  
 25 services in the field of wine, wine accessories, and other general merchandise related to  
 26 wine" in International Class 35, and "conducting educational programs relating to wine;  
 27 educational and entertainment services, namely podcasts and entertainment programs



1 relating to wine; production of travel shows relating to wine; online journals, namely,  
2 blogs featuring wine" in International Class 41.

3 16. Defendant's pending Application Serial No. 77/084749 for the mark THE WINE  
4 SCOUT has a filing date of January 17, 2007, and an alleged first use date for all  
5 services of January 19, 2006, both of which are dates long after Plaintiff initiated use of  
6 its WINE SCOUT Service Mark and Wine Scout International Trade Name in U.S.  
7 commerce.

8 17. In mid September of 2007, Plaintiff discovered that Defendant had filed her federal  
9 service mark application for the mark THE WINE SCOUT. This service mark  
10 application was filed on the Principal Register, indicating Defendant's belief that THE  
11 WINE SCOUT mark is distinctive and capable of registration.

12 18. Defendant's THE WINE SCOUT mark is confusingly similar to Plaintiff's WINE  
13 SCOUT Service Mark and Wine Scout International Trade Name given that the marks  
14 and the trade name are virtually identical in sight, sound, and meaning, and that the  
15 services offered by Defendant under THE WINE SCOUT are highly related to those  
16 which Plaintiff offers under its WINE SCOUT Service Mark and its Wine Scout  
17 International Trade Name.

18 19. Plaintiff has advised Defendant of Plaintiff's service mark and trade name rights in the  
19 term "WINE SCOUT" and has requested that Defendant cease use of her confusingly  
20 similar THE WINE SCOUT mark. However, Defendant has indicated that she does not  
21 intend to cease use of the mark THE WINE SCOUT in promoting and offering her  
22 various wine-related services despite repeated demands from Plaintiff and has instead  
23 demanded that Plaintiff cease use of its WINE SCOUT Service Mark.

24 20. Continued use of the mark THE WINE SCOUT by Defendant is likely to confuse  
25 consumers into believing that Defendant's THE WINE SCOUT online business and/or  
26  
27

her Internet website <http://thewinescout.com> are affiliated with, associated with, or connected to Plaintiff and/or the goods and services offered under Plaintiff's WINE SCOUT Service Mark and Wine Scout International Trade Name. Defendant will unjustly benefit from such false association.

21. As a result of Defendant's use of this confusingly similar mark, Plaintiff has lost control of its WINE SCOUT Service Mark and Wine Scout International Trade Name, and has been irreparably harmed. If Defendant is permitted to use and register her mark, any defect, objection, or fault found with Defendant's services marketed under THE WINE SCOUT necessarily would reflect upon and seriously injure the reputation Plaintiff has established for its services and products merchandised or marketed under its WINE SCOUT Service Mark and Wine Scout International Trade Name.

22. Upon information and belief, Defendant plans on continuing use of THE WINE SCOUT mark. Plaintiff has suffered, and continues to suffer, irreparable harm resulting from loss of control of its WINE SCOUT Service Mark and Wine Scout International Trade Name and such harm cannot be remedied solely by monetary damages. Unless restrained by this Court, Defendant will continue to unfairly compete with Plaintiff by using such mark, wherefore Plaintiff is without adequate remedy at law.

23. Upon information and belief, Defendant's infringing use of the confusingly similar THE WINE SCOUT mark has financially harmed Plaintiff by diminishing the value of Plaintiff's WINE SCOUT Service Mark and Wine Scout International Trade Name as a source indicator for Plaintiff's goods and services, and Defendant's infringing use of THE WINE SCOUT mark has increased the profitability of Defendant's THE WINE SCOUT brand and business to the detriment of Plaintiff.

24. This case is an exceptional case entitling Plaintiff to treble damages and attorneys' fees.

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**FIRST CAUSE OF ACTION**

(Federal Unfair Competition under 15 U.S.C. §1125(a))

25. Plaintiff restates and reavers the allegations of Paragraphs 1 through 24, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

26. The Defendant's above-averred actions constitute use in commerce of a word, name or device and false designation of origin which is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection or association of Defendant with Plaintiff or as to the origin, sponsorship or approval of the Defendant's services or the goods offered in connection therewith in violation of 15 U.S.C. §1125.

**SECOND CAUSE OF ACTION**

(State Unfair Competition under Cal. Bus. & Prof. Code §17200)

27. Plaintiff restates and reavers the allegations of Paragraphs 1 through 26, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

28. The Defendant's above-averred actions constitute unlawful, unfair or fraudulent business acts or practices in violation of Cal. Bus. & Prof. Code §17200.

**THIRD CAUSE OF ACTION**

(False or Misleading Statements under Cal. Bus. & Prof. Code §17500)

29. Plaintiff restates and reavers the allegations of Paragraphs 1 through 28, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

30. The Defendant's above-averred actions constitute the dissemination and making of untrue or misleading statements, which by the exercise of reasonable care should have been known to be false or misleading, in violation of Cal. Bus. & Prof. Code §17500.

**FOURTH CAUSE OF ACTION**

(Common Law Trademark Infringement)

31. Plaintiff restates and reavers the allegations of Paragraphs 1 through 30, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

32. The Defendant's above-averred actions constitute trademark infringement and passing off in violation of the common law of California.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff requests that judgment be entered as follows:

1. That Defendant, her principals, partners, agents, employees, licensees, affiliates, any parent and subsidiary companies, attorneys and representatives and all of those in privity with or acting under her direction and/or pursuant to her control, be preliminarily and permanently enjoined and restrained, from directly or indirectly:

- a. Using the mark THE WINE SCOUT, or terms or marks confusingly similar to WINE SCOUT, in connection with the advertisement, promotion, distribution, offering for sale or selling of wine, or products or services related to wine, including but not limited to, online ordering and retail store services in the field of wine, wine accessories, and general merchandise related to wine, advertising and marketing for goods and services related to wine, downloadable podcasts relating to wines distributed by any means whatsoever, educational programs relating to wine, and travel shows and blogs relating to wine, which may be produced or distributed in any media whatsoever;

b. Performing any acts or using any service marks, trademarks, names, words or phrases that are likely to cause confusion, to cause mistake, to deceive or otherwise mislead the trade or public into believing that Plaintiff and the Defendant are one in the same or are in some way connected or that Plaintiff is a sponsor of the Defendant or that the services or goods of the Defendant originate with Plaintiff or are likely to lead the trade or public to associate the Defendant with Plaintiff;

2. That Defendant be required to file with the Court, and serve on Plaintiff, a statement under oath evidencing compliance with any preliminary or permanent injunctive relief ordered by the Court within fourteen (14) days after the entry of such order of injunctive relief;

3. That Defendant, her principals, partners, agents, employees, licensees, affiliates, any parent and subsidiary companies, attorneys and representatives and all of those in privity with or acting under her direction and/or pursuant to her control, be required to deliver up for destruction all advertising, promotional, point of sale, press kit, packaging, and any other materials bearing the infringing mark THE WINE SCOUT, together with all artwork, graphics, and other means and materials for making and reproducing the same;

4. That the Commissioner for Trademarks of the United States Patent and Trademark Office be directed to refuse and deny registration of the service mark THE WINE SCOUT shown and specified in Application Serial No. 77/084749 based on a likelihood of confusion with Plaintiff's WINE SCOUT Service Mark and Wine Scout International Trade Name pursuant to 15 U.S.C. 1052(d);

5. That Defendant be ordered to pay Plaintiff monetary damages for the harm resulting from infringement of Plaintiff's mark, in an amount to be determined at trial;

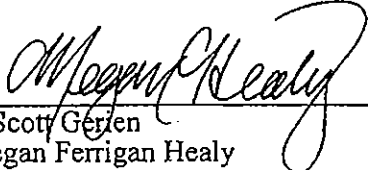
- 1           6.       That Plaintiff's damages be trebled and that Defendant be order to pay Plaintiff's  
2               attorneys' fees on the basis that this is an exceptional case;  
3           7.       That Plaintiff have such other and further relief as this Court shall deem just and  
4               proper on the merits.

5  
6           Dated: 11/20/2007

7  
8                       Respectfully submitted,

9                       DICKENSON, PEATMAN & FOGARTY

10  
11           By

12                         
13                       J. Scott Gerlen  
14                       Megan Ferrigan Healy

15                       809 Coombs Street  
16                       Napa, California 94559  
17                       Telephone: 707-252-7122  
18                       Facsimile: 707-255-6876

19                       Attorneys for Plaintiff,  
20                       Wine Scout International  
21  
22  
23  
24  
25  
26  
27

DP&F

DICKENSON, PEATMAN & FOGARTY  
A Professional Law Corporation

DEMAND FOR JURY TRIAL

Plaintiff hereby requests a trial by jury in this matter.

Dated: 11/20/2007

Respectfully submitted,

DICKENSON, PEATMAN & FOGARTY

By

  
J. Scott Gerien  
Megan Ferrigan Healy

809 Coombs Street  
Napa, California 94559  
Telephone: 707-252-7122  
Facsimile: 707-255-6876

Attorneys for Plaintiff,  
Wine Scout International

DP&F  
DICKENSON, PEATMAN & FOGARTY  
A Professional Law Corporation

## **EXHIBIT 3**



**Scott Gerien**

---

**From:** Scott Gerien  
**Sent:** Tuesday, January 22, 2008 3:55 PM  
**To:** 'andy.madrid@madrid-law.com'  
**Subject:** RE: Wine Scout v. Crowell

Hi Andy:

We won't move to default and the court is unlikely to act sua sponte at this point. To be honest, I don't have any electronic copies of an extension to answer since I changed firms a couple years back, but the Northern District is pretty informal about these things as far as form. Their local rules are on the web site if you wanted to check them out.

Sincerely,  
Scott

---

**From:** Andy Madrid [mailto:andy.madrid@madrid-law.com]  
**Sent:** Tuesday, January 22, 2008 3:50 PM  
**To:** Scott Gerien  
**Subject:** RE: Wine Scout v. Crowell

Scott: Thank you for agreeing to extend my client's time to respond to the complaint. It has been a long time since I had a case in the Northern District of California -- do we need an order or a stipulated order? If so, would you please send me a form that you would be comfortable submitting to the Court? Thanks.

Regards.  
Andy Madrid

---

**Andres N. Madrid, Esq.**  
45 West 21st Street, Suite 5A  
New York, New York 10010  
E-mail andy.madrid@madrid-law.com  
Tel. 212.404.6926  
Fax 917.536.9981

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---

**From:** Scott Gerien [mailto:Sgerien@dpf-law.com]  
**Sent:** Tuesday, January 22, 2008 3:55 PM  
**To:** andy.madrid@madrid-law.com  
**Subject:** RE: Wine Scout v. Crowell

Andy:

That's putting things close to the meet and confer deadline and I'd prefer to have the answer filed ahead of that. I will consent to a two week extension of the answer deadline as a compromise.

2/25/2008

Sincerely,  
Scott

---

**From:** Andy Madrid [mailto:andy.madrid@madrid-law.com]  
**Sent:** Tuesday, January 22, 2008 7:50 AM  
**To:** Scott Gerien  
**Subject:** RE: Wine Scout v. Crowell

Scott: Please let me know whether you and your client would agree to an extension of 30 days for my client to respond to the complaint. She never got the request of waiver you sent back in early December so, in view of her agreement to waiver formal service, we thought it would be appropriate for her to get a little more time to respond.

I thank you in advance for your anticipated cooperation. However, should you have any questions please do not hesitate to give me a call.

Regards.  
Andy Madrid

---

**Andres N. Madrid, Esq.**  
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New York, New York 10010  
E-mail andy.madrid@madrid-law.com  
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---

**From:** Scott Gerien [mailto:Sgerien@dpf-law.com]  
**Sent:** Tuesday, January 08, 2008 5:59 PM  
**To:** andy.madrid@madrid-law.com  
**Subject:** RE: Wine Scout v. Crowell

Thank you, Andy.

---

**From:** Andy Madrid [mailto:andy.madrid@madrid-law.com]  
**Sent:** Tuesday, January 08, 2008 2:53 PM  
**To:** Scott Gerien; madrid@madrid-law.com  
**Cc:** Megan Healy  
**Subject:** RE: Wine Scout v. Crowell

Scott: Attached is a signed waiver.

Regards.  
Andy Madrid

2/25/2008

---

**Andres N. Madrid, Esq.**

45 West 21st Street, Suite 5A  
New York, New York 10010  
E-mail [andy.madrid@madrid-law.com](mailto:andy.madrid@madrid-law.com)  
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---

**From:** Scott Gerien [<mailto:Sgerien@dpf-law.com>]  
**Sent:** Thursday, January 03, 2008 5:41 PM  
**To:** [madrid@madrid-law.com](mailto:madrid@madrid-law.com)  
**Cc:** Megan Healy  
**Subject:** Wine Scout v. Crowell

Dear Andy:

Attached is a copy of the Request for Waiver of Service of Summons that was mailed to your client on December 3, 2007. We have not received back the signed Waiver from your client. Unless you advise us by Monday, January 7, 2008 that your client is willing to accept service, we will have a process server proceed with service and expect your client to reimburse our client for the costs of such service pursuant to the Federal Rules.

Sincerely,  
Scott

J. Scott Gerien, Esq.  
Dickenson Peatman & Fogarty  
809 Coombs Street  
Napa, California 94559  
t - 707-252-7122  
f - 707-255-6876  
[sgerien@dpf-law.com](mailto:sgerien@dpf-law.com)  
[www.dpf-law.com](http://www.dpf-law.com)

2/25/2008

## **EXHIBIT 4**

## Service

Last updated: 02/22/08

- 
1. How does service work for efilings cases?
  2. Does **everyone** get served by ECF?
  3. How can I tell who is getting served by ECF and who is not?
  4. Do I have to file a Proof/Certificate of Service?
  5. Do I have to serve paper-copies of efiled documents?
  6. How does service work for non-efiling cases?

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SV01

### How does service work for efilings cases?

1. When an **efiling** occurs on a case in the ECF system, the system all the registered counsel and "watchers" of that case. This email called the **Notice of Electronic Filing** (or "NEF") and constitutes delivery of the document(s) and Proof of Service to all the registered counsel. The NEF clearly states:
  - **Who** efiled the document
  - **Who** was, and was not, served via email through ECF
  - **What** was efiled
  - **Where** the efiled document can be downloaded
  - **When** it was efiled

For all registered counsel, ECF does all the work so delivery of paper copies to opposing counsel and Proofs of Service are NOT required or desired by the court, since all registered counsel have agreed to accept service via ECF (per the ECF registration):

"BY SUBMITTING TO THE COURT A REQUEST FOR AN ECF USER ID AND PASSWORD, YOU CONSENT TO ENTRY OF YOUR E-MAIL ADDRESS INTO THE COURT'S ELECTRONIC SERVICE REGISTRY FOR ELECTRONIC SERVICE ON YOU OF ALL E-FILED PAPERS, PURSUANT TO RULES 77 and 5(b)(2)(D) (effective 12.1.01) OF THE FEDERAL RULES OF CIVIL PROCEDURE. YOU ALSO AGREE TO ABIDE BY ALL RULES AND PROCEDURES SET FORTH BY THE COURT, ESPECIALLY GENERAL ORDER 45, GENERAL ORDER 53, LOCAL RULE 5-4, AND AS SET FORTH ON THE ECF WEB SITE."

For all unregistered counsel and parties without counsel, all Federal and Local Rules apply regarding Service (the same as on a non-efiling case) - paper copies of the efiled documents must be delivered by the filing party (via mail, hand or otherwise) and a Proof of Service (just like a "paper-case") is required (which should be efiled).

2. When a **paper filing** occurs on a case in the ECF system, the court clerks will docket the filing in ECF and the system still emails the NEF to all the registered counsel and "watchers" of that case exactly as above, but the NEF will constitute only a notification that there has been a paper-filing at the court, not delivery of the document or Proof of Service. The NEF will not contain a link to the document as the court will not scan any documents for efilings. All Federal and Local Rules apply regarding Service (the same as on a non-efiling case) - paper copies of the efiled documents must be delivered by the filing party (via mail, hand or otherwise) to all the case participants (ECF registered or not) and a Proof of Service (just like a "paper-case") is required (which should be efiled). Unless the document filed in paper is excluded from efilings, then the filing party has ten (10) days to submit a PDF copy of what was filed via email (not ECF) to the court.

Typically, the only time you must serve in paper, and create a Proof of Service, is in the event that you have an exhibit too large to efile. If you file that exhibit on paper, you will also have to serve it on paper. In place of the actual document, you will efile a Manual Filing Notification for that exhibit.

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SV02

### **Does everyone get served by ECF?**

ECF only notifies counsel in a given case who are:

Registered for ECF in this district (each district is separate)  
**and**

Appearing on the docket as a counsel of record  
**and/or**  
Watching the case in question

ECF does nothing to serve unregistered counsel or parties without counsel. In fact, the court may do nothing to notify these entities - General Order 45, Section IX.D states that the court's orders in e-filing cases will be served via the email notice of electronic filing only, and no paper service will be made, regardless of whether counsel has yet registered as an e-filer. It is hoped that this will provide a strong incentive to register for those who have not yet done so.

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SV03

### **How can I tell who is getting served by ECF and who is not?**

You must do two things:

1. Check the docket to see if all parties have counsel. If they don't have counsel, ECF will not serve them.
2. In ECF, click on **Reports => Email Info for a Case**. This report will show all counsel of record, and if they will be served via ECF or not. This report is vital for completing your Proof of Service (if needed).

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SV04

### **Do I have to file a Proof/Certificate of Service?**

That depends -

- If all parties have counsel and all the counsel are registered for ECF, then NO ~ Proof of Service is not required or desired by the court.
- For all parties that don't have counsel and all counsel who are not

yet registered, a Proof of Service is required (which should be efiled) for the documents you must submit to them in paper.

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SV05

### **Do I have to serve paper-copies of efiled documents?**

First, per General Order 45, Section VI.G., all efilings must also be sent as "courtesy copies" for chambers. These are always in paper format and must be sent to court in the manner described in the General Orders.

Second, you must determine if any parties in the case do not have representation (counsel) yet. If they don't, you must serve them in paper, and efile your proof of service.

Last, you must determine if any counsel of record are not yet registered. If they aren't, you must serve them in paper, and efile your proof of service.

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SV07

### **How does service work for non-efiling cases?**

The same as it always has, all Federal and Local Rules apply, just like prior to the advent of ECF. Please click **[HERE](#)** for more info.

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## **EXHIBIT 5**

## Scott Gerien

---

**From:** Andy Madrid [andy.madrid@madrid-law.com]  
**Sent:** Monday, January 28, 2008 9:46 AM  
**To:** Scott Gerien  
**Subject:** RE: Wine Scout v. Crowell  
**Attachments:** WS Extension Stip.doc

Scott: As we discussed last Friday, attached is a proposed extension stipulation for your review. I believe it complies with Judge White's standing order, but please let me have your comments. If everything is in order, please execute it and file with the Court.

Regards.  
Andy Madrid

---

**Andres N. Madrid, Esq.**  
45 West 21st Street, Suite 5A  
New York, New York 10010  
E-mail andy.madrid@madrid-law.com  
Tel. 212.404.6926  
Fax 917.536.9981

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---

**From:** Scott Gerien [mailto:Sgerien@dpf-law.com]  
**Sent:** Tuesday, January 22, 2008 6:55 PM  
**To:** andy.madrid@madrid-law.com  
**Subject:** RE: Wine Scout v. Crowell

Hi Andy:

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Sincerely,  
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**Subject:** RE: Wine Scout v. Crowell

Scott: Thank you for agreeing to extend my client's time to respond to the complaint. It has been a long time since I had a case in the Northern District of California -- do we need an order or a stipulated order? If so, would

2/25/2008

you please send me a form that you would be comfortable submitting to the Court? Thanks.

Regards.  
Andy Madrid

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**Andres N. Madrid, Esq.**  
45 West 21st Street, Suite 5A  
New York, New York 10010  
E-mail andy.madrid@madrid-law.com  
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**Subject:** RE: Wine Scout v. Crowell

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Regards.  
Andy Madrid

---

**Andres N. Madrid, Esq.**  
45 West 21st Street, Suite 5A  
New York, New York 10010

2/25/2008

E-mail andy.madrid@madrid-law.com  
Tel. 212.404.6926  
Fax 917.536.9981

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**Sent:** Tuesday, January 08, 2008 5:59 PM  
**To:** andy.madrid@madrid-law.com  
**Subject:** RE: Wine Scout v. Crowell

Thank you, Andy.

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**Sent:** Tuesday, January 08, 2008 2:53 PM  
**To:** Scott Gerien; madrid@madrid-law.com  
**Cc:** Megan Healy  
**Subject:** RE: Wine Scout v. Crowell

Scott: Attached is a signed waiver.

Regards.  
Andy Madrid

---

**Andres N. Madrid, Esq.**  
45 West 21st Street, Suite 5A  
New York, New York 10010  
E-mail andy.madrid@madrid-law.com  
Tel. 212.404.6926  
Fax 917.536.9981

This e-mail may contain confidential communication. If you are not the intended recipient, you should: (1) Reply via e-mail to sender; (2) Destroy this communication entirely, including deletion of all associated text files from all individual and network storage devices; and (3) Refrain from copying or disseminating this communication by any means whatsoever. Thank you.

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**From:** Scott Gerien [mailto:Sgerien@dpf-law.com]  
**Sent:** Thursday, January 03, 2008 5:41 PM  
**To:** madrid@madrid-law.com  
**Cc:** Megan Healy  
**Subject:** Wine Scout v. Crowell

Dear Andy:

Attached is a copy of the Request for Waiver of Service of Summons that was mailed to your client on December 3, 2007. We have not received back the signed Waiver from your client. Unless you advise us by Monday, January 7, 2008 that your client is willing to accept service, we will have a process server proceed with service and expect your client to reimburse our client for the costs of such service pursuant to the Federal Rules.

2/25/2008

Sincerely,  
Scott

J. Scott Gerien, Esq.  
Dickenson Peatman & Fogarty  
809 Coombs Street  
Napa, California 94559  
t - 707-252-7122  
f - 707-255-6876  
[sgerien@dpf-law.com](mailto:sgerien@dpf-law.com)  
[www.dpf-law.com](http://www.dpf-law.com)

2/25/2008

## **EXHIBIT 6**

**Scott Gerien**

---

**From:** Stephen N. Hollman [shollman@businessandtechnologylawgroup.com]  
**Sent:** Thursday, February 14, 2008 3:14 PM  
**To:** Scott Gerien  
**Subject:** Re: Wine Scout International v. Crowell, USDC N.D. Cal., Case No. 3:07-cv-05930-JSW

From: Stephen Hollman

Scott: Wednesday afternoon at 3:00 p.m. would be more convenient for there is an out-of-office appointment on our calendar for 4:30 p.m.

It is agreed that we have not stipulated to anything at this point in time. We shall be local counsel, and can discuss at our next Telephone Conference the other matters you raise in your E-Mail below.

Scott Gerien wrote:

> Stephen:

>

> I am free to talk on Wednesday afternoon at about 4pm. So it is  
> clear, we have not stipulated to any extension of time for your client  
> to answer the complaint. While I am willing to consider a proposed  
> date, I don't believe your potential client needs a lot of time to  
> answer. Will you be lead counsel or will Andy? If its Andy, he's had  
> the complaint for some time and an answer should be fairly simple. If  
> it is you, and Andy will not be appearing in the matter at all, I am  
> willing to consent to some additional time for the answer, but I see  
> no reason under any circumstances why your client needs time beyond  
> 2/29 to answer the complaint. This will give us sufficient time ahead  
> of initial disclosures and the meet and confer to organize relevant information.

>  
> Let me know if 4pm on next Wednesday works for you.

>

> Sincerely,  
> Scott

>

> -----Original Message-----

> From: Stephen N. Hollman  
> [mailto:shollman@businessandtechnologylawgroup.com]  
> Sent: Thursday, February 14, 2008 2:11 PM  
> To: Scott Gerien  
> Subject: Re: Wine Scout International v. Crowell, USDC N.D. Cal., Case  
> No. 3:07-cv-05930-JSW

>

> From: Stephen N. Hollman

>

> Scott: This will confirm our Telephone Conference of this afternoon  
> in which we advised that this office will be appearing as counsel for  
> defendant in the above-entitled action.

>

> Because formalities such as an engagement letter and review of  
> documents have to be completed, we were not in a position to discuss  
> the litigation at that time.

>

> In light of our appearing for defendant, the obligation to file  
> responsive pleadings arranged by defendant's New York counsel would go  
> off calendar.

>

> We advised that since there was no Case Management Conference before  
> Judge White until April 25, 2008, under Local Rule 6-1 counsel were  
> free to set whatever dates they agree upon provided that such  
> arrangement does not affect the April 25th date.

>

> With both yours and our respective offices closed for the Federal

> holiday on Monday, February 17, 2008, we indicated that we should be  
> telephoning again on either Tuesday or Wednesday, February 18 or 19.  
> It now appears that the latter date is more likely.

>  
> Please advise by reply E-Mail of one or two alternate times on  
> Wednesday, February 19, when you would be free to have a Telephone  
> Conference.

> --  
> Stephen N. Hollman, Esq.  
> Business & Technology Law Group  
> 160 W. Santa Clara Street, Suite 1050  
> San Jose, CA 95113

> Tel: (408) 282-1949  
> Fax: (408) 275-9930  
> Email: info@businessandtechnologylawgroup.com

> RULE #1 -- If we do not properly take care of the needs of our  
> clients, another law firm will. So we abide by a simple and yet  
> powerful business rule -- WE SHALL GIVE TO EACH OF OUR CLIENTS MORE  
> THAN THEY EXPECT TO RECEIVE.

> You are invited to view our website at:

> <http://www.businessandtechnologylawgroup.com>

> -----IMPORTANT NOTICE-----

> This message is intended only for the use of the individual to whom  
> it is addressed, and may well contain information that is privileged,  
> confidential, and exempt from disclosure as a matter of law. Unless  
> you are the named addressee (or are authorized to receive this message  
> for the addressee), then you may not use, copy, or disclose this  
> message or any information contained in it and/or any attachment.  
> Moreover, if the message was received by you in error, then no  
> attorney-client relationship is thereby created by between you and the  
> sender of the message unless you are already a client of that sender.  
> If you have received this message in error, then kindly click on the  
> reply icon in your email program and so advise the sender.  
> Thanks so very much.

--  
Stephen N. Hollman, Esq.  
Business & Technology Law Group  
160 W. Santa Clara Street, Suite 1050  
San Jose, CA 95113

Tel: (408) 282-1949  
Fax: (408) 275-9930  
Email: info@businessandtechnologylawgroup.com

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will. So we abide by a simple and yet powerful business rule -- WE SHALL GIVE TO EACH OF  
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-----IMPORTANT NOTICE-----



This message is intended only for the use of the individual to whom it is addressed, and may well contain information that is privileged, confidential, and exempt from disclosure as a matter of law. Unless you are the named addressee (or are authorized to receive this message for the addressee), then you may not use, copy, or disclose this message or any information contained in it and/or any attachment. Moreover, if the message was received by you in error, then no attorney-client relationship is thereby created by between you and the sender of the message unless you are already a client of that sender. If you have received this message in error, then kindly click on the reply icon in your email program and so advise the sender.

Thanks so very much.

## **EXHIBIT 7**

Certificate of Electronic Filing

I hereby certify that this correspondence is being electronically filed with the Trademark Trial and Appeal Board through the ESTTA system located at <<http://estta.uspto.gov>>.

Dated: 2/25/08

By Jaymie Kilgore  
Jaymie Kilgore

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

Wine Scout International,  
Opposer,  
vs.  
Patricia Crowell,  
Applicant.

OPPOSITION NO.

NOTICE OF OPPOSITION

TO THE COMMISSIONER OF TRADEMARKS:

Wine Scout International, a corporation organized under the laws of the State of California and located at 975 First Street, Napa, California 94559 ("Opposer"), believes it will be damaged by registration of the mark THE WINE SCOUT for wine-related goods and services in International Classes 9, 35, and 41, as shown in application Serial No. 77/084749, filed on January 17, 2007, by Patricia Crowell ("Applicant"), and hereby opposes same.

Solely for the purpose of this proceeding, Opposer alleges the following as grounds for opposition:

- 1           1.     Applicant seeks to register THE WINE SCOUT as a service mark for  
2               “downloadable podcasts relating to wines and restaurants distributed by means of a  
3               global computer network” in International Class 9, “promotional services, namely,  
4               advertising and marketing for goods and services related to wine, online ordering  
5               and retail store services in the field of wine, wine accessories, and other general  
6               merchandise related to wine” in International Class 35, and “conducting  
7               educational programs relating to wine; educational and entertainment services,  
8               namely, podcast programs relating to wine; podcast travel shows relating to wine;  
9               online journals, namely, blogs featuring wine” in International Class 41, based on  
10              Applicant’s alleged use of such mark in commerce since January 19, 2006, as  
11              evidenced by the publication of such mark on February 12, 2008.
- 12           2.     Opposer is the owner of the service mark WINE SCOUT for mail order catalog  
13               services featuring wine, online retail store services featuring wine, providing  
14               information and advice to mail order catalog and online retail store customers  
15               concerning the purchase of wine, and has continuously used the WINE SCOUT  
16               mark on such services since 1996, which is earlier than any known date of first use  
17               or constructive filing date on which Applicant can rely. Opposer is also the owner  
18               of U.S. Trademark Application Serial No. 77/199035 for the mark THE WINE  
19               SCOUT for “mail order catalog services featuring wine; online retail store services  
20               featuring wine; providing information and advice to mail order catalog and online  
21               retail store customers concerning the purchase of wine” in International Class 35,  
22               filed on June 6, 2007, based on Opposer’s use of such mark in commerce since  
23               December 31, 1996.

- 1           3.     Opposer alleges that Applicant's applied-for mark is likely to cause confusion,  
2           mistake or to deceive the public. Applicant's THE WINE SCOUT mark is similar  
3           to Opposer's WINE SCOUT mark and the respective services on which the marks  
4           are used are virtually identical, substantially similar or related and said services are  
5           purchased by the same group of consumers. Accordingly, Applicant's mark is  
6           confusingly similar to Opposer's mark such that Applicant is not entitled to  
7           register its mark and Applicant's application should be denied in accordance with  
8           Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).
- 9           4.     Opposer avers that if Applicant is granted the registration herein opposed, it would  
10           interfere with Opposer's exclusive right to use its WINE SCOUT mark herein  
11           relied upon, all to the detriment and damage of Opposer. In addition, Applicant's  
12           THE WINE SCOUT mark has been cited by the USPTO as confusingly similar to  
13           Opposer's WINE SCOUT under Section 2(d) of the Trademark Act of 1946, 15  
14           U.S.C. §1052(d). Accordingly, Opposer avers that for the reasons aforesaid, it will  
15           be damaged by a grant of registration to Applicant of its trademark which is the  
16           subject of Serial No. 77/084749.

17  
18  
19     WHEREFORE, Opposer prays as follows:

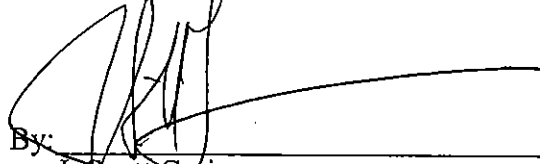
- 20           1.     That this Opposition be sustained;  
21           2.     That Application Serial No. 77/084749 be rejected; and  
22           3.     That registration of the trademark THE WINE SCOUT shown and specified in  
23           Application Serial No. 77/084749 be refused and denied.  
24  
25  
26  
27

1 Please charge Opposer's counsel's Deposit Account #503564 the \$300 filing fee for the  
2 Opposition.

3  
4 Dated: 2/25/08

Respectfully submitted,

DICKENSON, PEATMAN & FOGARTY

6  
7 

By: J. Scott Gerien  
Megan Healy

8  
9 809 Coombs Street  
10 Napa, California 94559  
11 Telephone: (707) 252-7122  
Facsimile: (707) 255-6876

12 Attorneys for Opposer  
13 WINE SCOUT INTERNATIONAL  
14  
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**PROOF OF SERVICE**

I declare that I am over the age of 18 years, employed in the County of Napa, and not a party to the within action; my business address is 809 Coombs Street, Napa, California 94559. On February 25, 2008, I served the attached **NOTICE OF OPPOSITION** on the person(s) listed below:

Andres N. Madrid, Esq.  
45 West 21st Street, Suite 5A  
New York, NY 10010  
Tel.: (212) 404-6926  
Fax: (917) 536-9981

by enclosing a true copy in a sealed envelope addressed as shown below and placing the envelope for collection and mailing following our ordinary business practices. I am readily familiar with this business' practice for collecting and processing correspondence for mailing. On the same day that correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service in a sealed envelope with postage fully prepaid.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed February 25, 2008, at Napa, California.

  
JAYMIE KILGORE

**Scott Gerien**

---

**From:** ESTTA@USPTO.GOV  
**Sent:** Monday, February 25, 2008 4:01 PM  
**To:** Scott Gerien; tmdept - IP Distribution  
**Subject:** Notice of Opposition

UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Trial and Appeal Board P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: February 25, 2008

Opposition No. 91182634  
Serial No. 77084749

Andres N. Madrid  
Andres N. Madrid, Esq.  
45 West 21st St. Suite 5A  
New York, NY 10010  
andy.madrid@madrid-law.com  
Wine Scout International

v.

Crowell, Patricia

J. Scott Gerien  
Dickenson Peatman & Fogarty  
809 Coombs Street  
Napa, CA 94559  
sgerien@dpf-law.com, tmdept@dpf-law.com

ESTTA194663

A notice of opposition to the registration sought by the above-identified application has been filed. A service copy of the notice of opposition was forwarded to applicant (defendant) by the opposer (plaintiff). An electronic version of the notice of opposition is viewable in the electronic file for this proceeding via the Board's TTABVue system: <http://ttabvue.uspto.gov/ttabvue/v?qs=91182634>.

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations ("Trademark Rules"). These rules may be viewed at the USPTO's trademarks page: <http://www.uspto.gov/main/trademarks.htm>. The Board's main webpage (<http://www.uspto.gov/web/offices/dcom/ttab/>) includes information on amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

Plaintiff must notify the Board when service has been ineffective, within 10 days of the date of receipt of a returned service copy or the date on which plaintiff learns that service has been ineffective. Plaintiff has no subsequent duty to investigate the defendant's whereabouts, but if plaintiff by its own voluntary investigation or through any other means discovers a newer correspondence address for the defendant, then such address must be provided to the Board. Likewise, if by voluntary investigation or other



means the plaintiff discovers information indicating that a different party may have an interest in defending the case, such information must be provided to the Board. The Board will then effect service, by publication in the Official Gazette if necessary. See Trademark Rule 2.118. In circumstances involving ineffective service or return of defendant's copy of the Board's institution order, the Board may issue an order noting the proper defendant and address to be used for serving that party.

Defendant's ANSWER IS DUE FORTY DAYS after the mailing date of this order.

(See Patent and Trademark Rule 1.7 for expiration of this or any deadline falling on a Saturday, Sunday or federal holiday.) Other deadlines the parties must docket or calendar are either set forth below (if you are reading a mailed paper copy of this order) or are included in the electronic copy of this institution order viewable in the Board's TTABVue system at the following web address: <http://ttabvue.uspto.gov/ttabvue/>.

Defendant's answer and any other filing made by any party must include proof of service. See Trademark Rule 2.119. If they agree to, the parties may utilize electronic means, e.g., e-mail or fax, during the proceeding for forwarding of service copies. See Trademark Rule 2.119(b)(6).

The parties also are referred in particular to Trademark Rule 2.126, which pertains to the form of submissions. Paper submissions, including but not limited to exhibits and transcripts of depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

As noted in the schedule of dates for this case, the parties are required to have a conference to discuss: (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case. See Trademark Rule 2.120(a)(2). Discussion of the first two of these three subjects should include a discussion of whether the parties wish to seek mediation, arbitration or some other means for resolving their dispute.

Discussion of the third subject should include a discussion of whether the Board's Accelerated Case Resolution (ACR) process may be a more efficient and economical means of trying the involved claims and defenses.

Information on the ACR process is available at the Board's main webpage.

Finally, if the parties choose to proceed with the disclosure, discovery and trial procedures that govern this case and which are set out in the Trademark Rules and Federal Rules of Civil Procedure, then they must discuss whether to alter or amend any such procedures, and whether to alter or amend the Standard Protective Order (further discussed below).

Discussion of alterations or amendments of otherwise prescribed procedures can include discussion of limitations on disclosures or discovery, willingness to enter into stipulations of fact, and willingness to enter into stipulations regarding more efficient options for introducing at trial information or material obtained through disclosures or discovery.

The parties are required to conference in person, by telephone, or by any other means on which they may agree. A Board interlocutory attorney or administrative trademark judge will participate in the conference, upon request of any party, provided that such participation is requested no later than ten (10) days prior to the deadline for the conference. See Trademark Rule 2.120(a)(2). The request for Board participation must be made through the Electronic System for Trademark Trials and Appeals (ESTTA) or by telephone call to the interlocutory attorney assigned to the case, whose name can be found by referencing the TTABVue record for this case at <http://ttabvue.uspto.gov/ttabvue/>. The parties should contact the assigned interlocutory attorney or file a request for Board participation through ESTTA only after the parties have agreed on possible dates and times for their conference. Subsequent participation of a Board attorney or judge in the conference will be by telephone and the parties shall place the call at the agreed date and time, in the absence of other arrangements made with the assigned interlocutory attorney.

The Board's Standard Protective Order is applicable to this case, but the parties may agree to supplement that standard order or substitute a protective agreement of their choosing, subject to approval by the Board.

The standard order is available for viewing at:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>. Any party without access to the web may request a hard copy of the standard order from the Board. The standard order does not automatically protect a party's confidential information and its provisions must be utilized as needed by the parties. See Trademark Rule 2.116(g).

Information about the discovery phase of the Board proceeding is available in chapter 400 of the TBMP. By virtue of amendments to the Trademark Rules effective November 1, 2007, the initial disclosures and expert disclosures scheduled during the discovery phase are required only in cases commenced on or after that date. The TBMP has not yet been amended to include information on these disclosures and the parties are referred to the August 1, 2007 Notice of Final Rulemaking (72 Fed. Reg. 42242) posted on the Board's webpage. The deadlines for pretrial disclosures included in the trial phase of the schedule for this case also resulted from the referenced amendments to the Trademark Rules, and also are discussed in the Notice of Final Rulemaking.

The parties must note that the Board allows them to utilize telephone conferences to discuss or resolve a wide range of interlocutory matters that may arise during this case. In addition, the assigned interlocutory attorney has discretion to require the parties to participate in a telephone conference to resolve matters of concern to the Board. See TBMP § 502.06(a) (2d ed. rev. 2004).

The TBMP includes information on the introduction of evidence during the trial phase of the case, including by notice of reliance and by taking of testimony from witnesses. See TBMP §§ 703 and 704. Any notice of reliance must be filed during the filing party's assigned testimony period, with a copy served on all other parties. Any testimony of a witness must be both noticed and taken during the party's testimony period. A party that has taken testimony must serve on any adverse party a copy of the transcript of such testimony, together with copies of any exhibits introduced during the testimony, within thirty (30) days after the completion of the testimony deposition. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.

If the parties to this proceeding are (or during the pendency of this proceeding become) parties in another Board proceeding or a civil action involving related marks or other issues of law or fact which overlap with this case, they shall notify the Board immediately, so that the Board can consider whether consolidation or suspension of proceedings is appropriate.

ESTTA NOTE: For faster handling of all papers the parties need to file with the Board, the Board strongly encourages use of electronic filing through the Electronic System for Trademark Trials and Appeals (ESTTA).

Various electronic filing forms, some of which may be used as is, and others which may require attachments, are available at <http://estta.uspto.gov>.

## **EXHIBIT 8**

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service in an envelope addressed to United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia, 22313-1451.

Dated: 2/26/08

By

  
Jaymie Kilgore

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

Wine Scout International,  
Opposer,  
vs.  
Patricia Crowell,  
Applicant.

OPPOSITION NO. 91182634

OPPOSER WINE SCOUT  
INTERNATIONAL'S MOTION TO  
SUSPEND PROCEEDINGS PURSUANT TO  
TBMP SECTION 510.02

I. MOTION

Pursuant to TBMP Section 510.02, Opposer, Wine Scout International, hereby requests that these proceedings be suspended by the Board pending the outcome of Case No. C07-05930 filed by Opposer against Applicant Patricia Crowell ("Applicant") in the United States District Court for the Northern District of California. A copy of the complaint in the referenced case is attached hereto as Exhibit 1.

II. ARGUMENT

TBMP Section 510.02(a) states: "Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action."

1 "To the extent that a civil action in a Federal district court involves issues in common with  
2 those in a proceeding before the Board, the decision of the Federal district court is often binding  
3 upon the Board, while the decision of the Board is not binding upon the Court." Id.

4 The basis for Opposer's opposition action is Section 2(d) likelihood of consumer  
5 confusion. As indicated in the attached complaint, Opposer's basis for its federal action against  
6 Applicant is also likelihood of consumer confusion related to the same marks. See Paragraphs  
7 25-32. Accordingly, both actions directly involve the issue of likelihood of confusion concerning  
8 the same marks.

9 In the complaint, the Opposer also requested that the Court order the USPTO to refuse and  
10 deny registration of the application which is the subject of this opposition proceeding. See,  
11 Prayer, Paragraph 4. This further evidences that the outcome of the federal action will have a  
12 direct bearing on the issues before the Board and that the opposition action should therefore be  
13 suspended. See General Motors Corp. v. Cadillac Club Fashions, Inc., 22 USPQ 1933 (TTAB  
14 1992).

15 Accordingly, Opposer Wine Scout International respectfully requests that the opposition  
16 proceeding be suspended pending the outcome of the federal action, Case No. C07-05930,  
17 pending in the Northern District of California.

18 Dated: 2/26/08

19 Respectfully submitted,

20 DICKENSON, PEATMAN & FOGARTY

21 By:   
22

23 J. Scott Gerien  
Megan Healy

24 809 Coombs Street  
25 Napa, California 94559  
26 Telephone: (707) 252-7122  
27 Facsimile: (707) 255-6876

Attorneys for Opposer, Wine Scout International

**Certificate of Mailing**

I, Jaymie Kilgore, am employed in the County of Napa. I am over the age of eighteen years and am not a party to the above-entitled action; my business address is 809 Coombs Street, Napa, CA 94559.

I am readily familiar with the business practice at my place of business for collection and processing of correspondence for personal delivery, for mailing with the United States Postal Service, for facsimile, and for overnight delivery by Federal Express, Express Mail, and other overnight services.

On February 26, 2008, I placed a copy of the following document(s):

OPPOSER WINE SCOUT INTERNATIONAL'S MOTION TO SUSPEND  
PROCEEDINGS PURSUANT TO TBMP SECTION 510.02

in a sealed envelope, addressed to and arranged for service consistent with the ordinary business practices as follows:

**Andres N. Madrid, Esq.**  
**45 West 21st Street, Suite 5A**  
**New York, NY 10010**  
**Tel.: (212) 404-6926**  
**Fax: (917) 536-9981**

☒ BY MAIL: Such correspondence was deposited, with postage fully prepaid, with the United States Postal Service on the same day in the ordinary course of business.

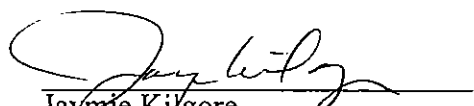
☐ BY FEDERAL EXPRESS: By placing a true copy of said document(s), enclosed in a sealed envelope, and by depositing said envelope, fully prepaid, with Federal Express, in Napa, California, on the same day in the ordinary course of business.

☐ BY PERSONAL SERVICE: Such envelope was delivered by hand to the offices of the addressee.

☐ BY FACSIMILE: Such document was faxed to the facsimile transmission machine with the facsimile machine number stated above. Upon completion of the transmission, the transmitting machine issued a transmission report showing the transmission was complete and without error.

I declare under penalty of perjury that the above is true and correct.

Executed on February 26, 2008 at Napa, California.

  
Jaymie Kilgore

## **EXHIBIT 1**

J. SCOTT GERIEN, State Bar No. 184728  
MEGAN FERRIGAN HEALY, State Bar No. 229177  
DICKENSON, PEATMAN & FOGARTY  
809 Coombs Street  
Napa, California 94559  
Telephone: (707) 252-7122  
Facsimile: (707) 255-6876

Attorneys for Plaintiff  
WINE SCOUT INTERNATIONAL

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

Wine Scout International,  
  
Plaintiff,  
  
vs.  
  
Patricia Crowell,  
  
Defendant.

CASE NO.

**COMPLAINT**

1. Federal Unfair Competition
2. California Unfair Competition
3. California False or Misleading Statements
4. Common Law Trademark Infringement

**DEMAND FOR JURY TRIAL**

Plaintiff, Wine Scout International ("Plaintiff"), for its complaint against Defendant, Patricia Crowell ("Defendant"), alleges as follows:

**NATURE OF ACTION**

1. This is an action to redress violations of the federal Lanham Act for unfair competition (15 U.S.C. §1125(a)), violations of the California Business and Professions Code for unfair competition (Cal. Bus. & Prof. Code §17200) and the dissemination of false and misleading statements (Cal. Bus. & Prof. Code §17500), and common law trademark infringement, as the result of willful and unauthorized use by Defendant of colorable imitations of Plaintiff's service mark and trade name, as more fully set forth hereinafter.

Plaintiff seeks preliminary and permanent injunctive relief restraining Defendant's

E-filing

ORIGINAL  
FILED

NOV 26 2007

RICHARD W. WIEKING  
CLERK U.S. DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
OAKLAND

ADR

07-05930

PVT



1 infringement of Plaintiff's service mark, monetary damages, attorneys' fees and related  
2 relief.

3 **THE PARTIES**

- 4 2. Plaintiff Wine Scout International is a California corporation with its principal place of  
5 business located at 975 First Street, Napa, California, 94559.  
6  
7 3. Upon information and belief, Defendant is an individual with a principal place of  
8 business located at PMB 110, 11357 Nuckols Road, Glen Allen, Virginia 23059.

9 **JURISDICTION AND VENUE**

- 10 4. This Court has subject matter jurisdiction over Plaintiff's claim under and pursuant to  
11 15 U.S.C. §1121 and 28 U.S.C. §1338(a), as the claims arise under the federal Lanham  
12 Act, 15 U.S.C. §§1051-1127. This Court also has pendent jurisdiction over all related  
13 claims herein in accordance with 28 U.S.C. §1338(b).  
14  
15 5. Upon information and belief, Defendant, either directly or through her agents,  
16 transacted business in the State of California and within this judicial district through the  
17 provision of services in this judicial district via a nationally accessible Internet website,  
18 as more specifically set forth below, and expected or should reasonably have expected  
19 her acts to have consequence in the State of California and within this judicial district.  
20  
21 6. Venue is proper in this district pursuant to 28 U.S.C. §1391(b), as Defendant is doing  
22 business in this judicial district through the provision of services via a nationally  
23 accessible Internet website, as more specifically set forth below, and therefore may be  
24 found in this district, and/or as a substantial part of the events giving rise to the claims  
25 alleged herein occurred in this judicial district, and/or the infringement occurred in this  
26 judicial district.  
27

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**ALLEGATIONS COMMON TO ALL CLAIMS**

7. Plaintiff is the owner of the distinctive service mark WINE SCOUT for various wine-related services, including mail order catalog services featuring wine, online retail store services featuring wine, and the provision of information and advice to catalog and online retail store customers concerning wine (the "WINE SCOUT Service Mark").
8. Plaintiff is the owner of the trade name Wine Scout International as used in association with wine and various wine-related services (the "Wine Scout International Trade Name"). Plaintiff uses the Wine Scout International Trade Name as a négociant and vintner to have wines produced under various proprietary labels. Plaintiff has sold over one million bottles of wine featuring the Wine Scout International Trade Name as the producer. Plaintiff is known and referred to colloquially by the industry and the public by such Wine Scout International Trade Name.
9. Long prior to the acts of Defendant complained of herein, Plaintiff has used its WINE SCOUT Service Mark in association with its wine-related services in U.S. commerce, including mail order catalog services featuring wine, online retail store services featuring wine, the provision of information and advice to catalog and online retail store customers concerning wine.
10. Long prior to the acts of Defendant complained of herein, Plaintiff has used its Wine Scout International Trade Name in association with its wine-related services, including its négociant and vintner services, and in such capacity has produced over one million bottles of wine bearing the Wine Scout International Trade Name.
11. Plaintiff owns extremely valuable goodwill which is symbolized by its WINE SCOUT Service Mark and its Wine Scout International Trade Name and each use of the mark and the trade name substantially increases the value of Plaintiff's company and the salability of the goods and services sold through Plaintiff's company.

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12. Upon information and belief, Defendant, Patricia Crowell is the owner of an Internet business operated under the service mark THE WINE SCOUT, accessible at <http://thewinescout.com>, through which Defendant offers promotional services relating to the advertisement and marketing of wine, wineries, wine tasting kits, wine vacations, and other wine-oriented goods and services, provides audio and video podcasts and other downloadable information about wine, and offers educational programs and travel shows related to wine.
13. Defendant's website, accessible at <http://thewinescout.com>, prominently features the mark THE WINE SCOUT throughout the site, as well as throughout Defendant's downloadable wine-centered audio and video podcasts, programs, and blogs. Upon information and belief, in addition to being available to consumers via Defendant's <http://thewinescout.com> website, Defendant's downloadable THE WINE SCOUT podcasts are available on Apple iTunes and numerous other podcast aggregators and directories.
14. Upon information and belief, Defendant willfully adopted and initiated use of THE WINE SCOUT service mark with prior knowledge of Plaintiff's WINE SCOUT Service Mark and Wine Scout International Trade Name.
15. Upon information and belief, Defendant is the owner of pending federal Service Mark Application Serial No. 77/084749 for the mark THE WINE SCOUT for "downloadable podcasts relating to wines and restaurants distributed by means of a global computer network" in International Class 9, "promotional services, namely advertising and marketing for goods and services related to wine, online ordering and retail store services in the field of wine, wine accessories, and other general merchandise related to wine" in International Class 35, and "conducting educational programs relating to wine; educational and entertainment services, namely podcasts and entertainment programs

1 relating to wine; production of travel shows relating to wine; online journals, namely,  
2 blogs featuring wine" in International Class 41.

3 16. Defendant's pending Application Serial No. 77/084749 for the mark THE WINE  
4 SCOUT has a filing date of January 17, 2007, and an alleged first use date for all  
5 services of January 19, 2006, both of which are dates long after Plaintiff initiated use of  
6 its WINE SCOUT Service Mark and Wine Scout International Trade Name in U.S.  
7 commerce.

8  
9 17. In mid September of 2007, Plaintiff discovered that Defendant had filed her federal  
10 service mark application for the mark THE WINE SCOUT. This service mark  
11 application was filed on the Principal Register, indicating Defendant's belief that THE  
12 WINE SCOUT mark is distinctive and capable of registration.

13 18. Defendant's THE WINE SCOUT mark is confusingly similar to Plaintiff's WINE  
14 SCOUT Service Mark and Wine Scout International Trade Name given that the marks  
15 and the trade name are virtually identical in sight, sound, and meaning, and that the  
16 services offered by Defendant under THE WINE SCOUT are highly related to those  
17 which Plaintiff offers under its WINE SCOUT Service Mark and its Wine Scout  
18 International Trade Name.

19  
20 19. Plaintiff has advised Defendant of Plaintiff's service mark and trade name rights in the  
21 term "WINE SCOUT" and has requested that Defendant cease use of her confusingly  
22 similar THE WINE SCOUT mark. However, Defendant has indicated that she does not  
23 intend to cease use of the mark THE WINE SCOUT in promoting and offering her  
24 various wine-related services despite repeated demands from Plaintiff and has instead  
25 demanded that Plaintiff cease use of its WINE SCOUT Service Mark.

26  
27 20. Continued use of the mark THE WINE SCOUT by Defendant is likely to confuse  
consumers into believing that Defendant's THE WINE SCOUT online business and/or

1 her Internet website <http://thewinescout.com> are affiliated with, associated with, or  
2 connected to Plaintiff and/or the goods and services offered under Plaintiff's WINE  
3 SCOUT Service Mark and Wine Scout International Trade Name. Defendant will  
4 unjustly benefit from such false association.

5 21. As a result of Defendant's use of this confusingly similar mark, Plaintiff has lost  
6 control of its WINE SCOUT Service Mark and Wine Scout International Trade Name,  
7 and has been irreparably harmed. If Defendant is permitted to use and register her  
8 mark, any defect, objection, or fault found with Defendant's services marketed under  
9 THE WINE SCOUT necessarily would reflect upon and seriously injure the reputation  
10 Plaintiff has established for its services and products merchandised or marketed under  
11 its WINE SCOUT Service Mark and Wine Scout International Trade Name.

12 22. Upon information and belief, Defendant plans on continuing use of THE WINE  
13 SCOUT mark. Plaintiff has suffered, and continues to suffer, irreparable harm resulting  
14 from loss of control of its WINE SCOUT Service Mark and Wine Scout International  
15 Trade Name and such harm cannot be remedied solely by monetary damages. Unless  
16 restrained by this Court, Defendant will continue to unfairly compete with Plaintiff by  
17 using such mark, wherefore Plaintiff is without adequate remedy at law.

18 23. Upon information and belief, Defendant's infringing use of the confusingly similar  
19 THE WINE SCOUT mark has financially harmed Plaintiff by diminishing the value of  
20 Plaintiff's WINE SCOUT Service Mark and Wine Scout International Trade Name as a  
21 source indicator for Plaintiff's goods and services, and Defendant's infringing use of  
22 THE WINE SCOUT mark has increased the profitability of Defendant's THE WINE  
23 SCOUT brand and business to the detriment of Plaintiff.

24 24. This case is an exceptional case entitling Plaintiff to treble damages and attorneys' fees.

**FIRST CAUSE OF ACTION**

(Federal Unfair Competition under 15 U.S.C. §1125(a))

25. Plaintiff restates and reavers the allegations of Paragraphs 1 through 24, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

26. The Defendant's above-averred actions constitute use in commerce of a word, name or device and false designation of origin which is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection or association of Defendant with Plaintiff or as to the origin, sponsorship or approval of the Defendant's services or the goods offered in connection therewith in violation of 15 U.S.C. §1125.

**SECOND CAUSE OF ACTION**

(State Unfair Competition under Cal. Bus. & Prof. Code §17200)

27. Plaintiff restates and reavers the allegations of Paragraphs 1 through 26, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

28. The Defendant's above-averred actions constitute unlawful, unfair or fraudulent business acts or practices in violation of Cal. Bus. & Prof. Code §17200.

**THIRD CAUSE OF ACTION**

(False or Misleading Statements under Cal. Bus. & Prof. Code §17500)

29. Plaintiff restates and reavers the allegations of Paragraphs 1 through 28, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

30. The Defendant's above-averred actions constitute the dissemination and making of untrue or misleading statements, which by the exercise of reasonable care should have been known to be false or misleading, in violation of Cal. Bus. & Prof. Code §17500.

**FOURTH CAUSE OF ACTION**

(Common Law Trademark Infringement)

31. Plaintiff restates and reavers the allegations of Paragraphs 1 through 30, inclusive, and the acts of Defendant asserted therein as if set forth in full as part of this Cause of Action.

32. The Defendant's above-averred actions constitute trademark infringement and passing off in violation of the common law of California.

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff requests that judgment be entered as follows:

1. That Defendant, her principals, partners, agents, employees, licensees, affiliates, any parent and subsidiary companies, attorneys and representatives and all of those in privity with or acting under her direction and/or pursuant to her control, be preliminarily and permanently enjoined and restrained, from directly or indirectly:

a. Using the mark THE WINE SCOUT, or terms or marks confusingly similar to WINE SCOUT, in connection with the advertisement, promotion, distribution, offering for sale or selling of wine, or products or services related to wine, including but not limited to, online ordering and retail store services in the field of wine, wine accessories, and general merchandise related to wine, advertising and marketing for goods and services related to wine, downloadable podcasts relating to wines distributed by any means whatsoever, educational programs relating to wine, and travel shows and blogs relating to wine, which may be produced or distributed in any media whatsoever;

- b. Performing any acts or using any service marks, trademarks, names, words or phrases that are likely to cause confusion, to cause mistake, to deceive or otherwise mislead the trade or public into believing that Plaintiff and the Defendant are one in the same or are in some way connected or that Plaintiff is a sponsor of the Defendant or that the services or goods of the Defendant originate with Plaintiff or are likely to lead the trade or public to associate the Defendant with Plaintiff;
2. That Defendant be required to file with the Court, and serve on Plaintiff, a statement under oath evidencing compliance with any preliminary or permanent injunctive relief ordered by the Court within fourteen (14) days after the entry of such order of injunctive relief;
3. That Defendant, her principals, partners, agents, employees, licensees, affiliates, any parent and subsidiary companies, attorneys and representatives and all of those in privity with or acting under her direction and/or pursuant to her control, be required to deliver up for destruction all advertising, promotional, point of sale, press kit, packaging, and any other materials bearing the infringing mark THE WINE SCOUT, together with all artwork, graphics, and other means and materials for making and reproducing the same;
4. That the Commissioner for Trademarks of the United States Patent and Trademark Office be directed to refuse and deny registration of the service mark THE WINE SCOUT shown and specified in Application Serial No. 77/084749 based on a likelihood of confusion with Plaintiff's WINE SCOUT Service Mark and Wine Scout International Trade Name pursuant to 15 U.S.C. 1052(d);
5. That Defendant be ordered to pay Plaintiff monetary damages for the harm resulting from infringement of Plaintiff's mark, in an amount to be determined at trial;



- 1           6.     That Plaintiff's damages be trebled and that Defendant be order to pay Plaintiff's  
2           attorneys' fees on the basis that this is an exceptional case;  
3           7.     That Plaintiff have such other and further relief as this Court shall deem just and  
4           proper on the merits.  
5

6           Dated: 11/20/2007  
7

8           Respectfully submitted,

9           DICKENSON, PEATMAN & FOGARTY

10  
11           By 

12           J. Scott Geylen  
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18           Attorneys for Plaintiff,  
19           Wine Scout International  
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DEMAND FOR JURY TRIAL

Plaintiff hereby requests a trial by jury in this matter.

Dated: 11/20/2007

Respectfully submitted,

DICKENSON, PEATMAN & FOGARTY

By

  
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